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IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

No. 1424

THE EIMCO CORPORATION, *Petitioner,*

v.

PETERSON FILTERS AND ENGINEERING COMPANY AND KOMLINE-SANDERSON ENGINEERING CORPORATION, *Respondents.*

BRIEF OF RESPONDENTS IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT

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Respondents, Peterson Filters and Engineering Company and Komline-Sanderson Engineering Corporation, file this brief in opposition to a petition by The Eimco Corporation that this Court review a judgment of the United States Court of Appeals for the Tenth Circuit entered in the above entitled cause on December 30, 1968.

INACCURACIES IN PETITIONER'S QUESTIONS PRESENTED FOR REVIEW AND STATEMENT OF THE CASE

Petitioner presents two questions for review and bases both on asserted facts of its own invention and contrary to the findings of the Trial Court as affirmed by the Court of Appeals.

In its first Question for Review, petitioner says that both lower courts found "the sole point of novelty" was the use of springs or other resilient means (Petition, p. 3) in the claimed apparatus. However, the Court of Appeals for the Tenth Circuit, in its opinion, said that ". . . the new element claimed in this combination was a filter belt guide which continuously and automatically realigns the belt before it returns to the drum surface." (A-4) The Court of Appeals went on to describe further the "realignment device", which includes springs, and the operation of the device. But the new element is a filter belt guide, comprising several cooperating parts, not merely springs.

Likewise, the statement that there are several "alternative" structures is an idea of petitioner unsupported by the record. The word "alternative" is not used in either of the two lower court decisions, nor is it found in the patent in suit. Yet petitioner has the temerity to declare that the patent discloses "alternative" structures no less than seven times in its petition. Thus, two important facts on which petitioner bases Question No. 1 for Review and iterates in its Statement of the Case are simply not of record and not factual.

Petitioner's Question No. 2 for Review is also based on an assertion of fact that is directly contrary to the record. Petitioner says that the issue is whether the

doctrine of equivalents is available where claims were cancelled in response to a dual ground of rejection. As petitioner well knows, the trial court made detailed Findings 37 to 39 (A-33, 34), specifically affirmed by the Court of Appeals, which stated at A-17:

> "The trial court found that the critical phrase was included in the patent to overcome a Patent Office rejection because the language of the claims was indefinite and misdescriptive, and not to avoid a rejection on the prior art. The record sustains these findings."

Thus, petitioner's second Question for Review based on an insertion made in the claims after a supposed "dual ground" of rejection, is inaccurate, flaunts the record, and leaves the Question unanswerable.

Much of the Statement of the Case tries to establish as fact the misstatements of the Questions. Petitioner is apparently trying to make a new record on appeal more to its liking, but this effort makes it impossible to reach any Questions this Court might deem worthy of review.

PETITIONER'S REASONS FOR GRANTING THE WRIT DO NOT WARRANT REVIEW BY THIS COURT

1. The Question of Whether One Device Is Obvious in View of Another Is One of Fact Not Worthy of Review.

The subject matter of this case is complex. It involves a rotary vacuum belt filter that is of great dimensions as well as intricacy. Belt filters are used to filter sludge from the sewage lines of cities. The Trial Court made a painstaking examination of the claimed apparatus of the patent in suit and visited the Weber County Sewage Treatment Plant at Ogden, Utah (R. 1553), as well as petitioner's plant in Salt Lake City

(R. 1782). During such visits the Trial Judge viewed the infringing apparatus in operation. He also heard the testimony of experts of petitioner and respondent with respect to the disclosure of the prior art. Yet, petitioner, on the basis of its own determination of the point of novelty and its own finding of "alternative" structures, asks this Court to substitute its judgment on a question of fact—obviousness—for that of both lower courts. It asks the Supreme Court of the United States to act as a super trial court, to overrule the findings of the United States District Court for the District of Utah, and to contradict its own recent pronouncement in *Zenith Radio Corp.* v. *Hazeltine Research, Inc.,* U.S. (May 19, 1969), where the Court said:

> "In applying the clearly erroneous standard to the findings of a district court sitting without a jury, appellate courts must constantly have in mind that their function is not to decide factual issues de novo. The authority of an appellate court, when reviewing the findings of a judge as well as those of a jury, is circumscribed by the deference it must give to decisions of the trier of the fact, who is usually in a superior position, to appraise and weigh the evidence."

While respondents sincerely believe that the Trial Court, as affirmed by the Court of Appeals, properly analyzed the prior art in its findings of fact, if this Court undertakes a review of complex apparatus as in the case at bar in every patent case, the work of this Court will be multiplied by an impossible exponential factor. *Graham* v. *John Deere Co.,* 383 U.S. 1 (1966) clarified and affirmed the bases of nonobviousness. The Trial Court and Court of Appeals, the latter quoting *Graham* at length (A-9, 10), followed the standard

laid down by this Court. A review of facts in complex patent cases cannot be expected of this Court when so clearly the facts were ascertained with the correct standard of this Court in mind.

2. The Propriety of a Range of Equivalents Is a Question of Fact and Unworthy of Review.

The District Court held as a matter of fact that where the identical tracking and tensioning device was used in varying locations by petitioner, it was ". . . an equivalent variation which would be obvious to one possessing ordinary skill in the art." (A-36) The Court of Appeals agreed ". . . that the placing of the equipment between the rollers or between the drum and the discharge roller is inconsequential and is merely a substitution of equivalents." (A-14, 15) Thus, the two lower courts decided that certain apparatus used by the petitioner was equivalent in various locations. Now petitioner seeks still another review from this Court.

Yet a finding of equivalence or lack thereof is, again, one of fact. As this Court said in *Graver Tank & Mfg. Co., Inc.* v. *Linde Air Products Co.,* 339 U.S. 605, 609, 610 (1950):

> "A finding of equivalence is a determination of fact . . . It is to be decided by the trial court and that court's decision, under general principles of appellate reveiw, should not be disturbed unless clearly erroneous."

After mistakenly urging that the phrase "adjacent each end of the return roller" was inserted in response to a dual rejection, petitioner chooses to rely, albeit hesitatingly, on *Exhibit Supply Co.* v. *Ace Corp.,* 315 U.S. 126 (1942), although its reason for reliance is

not apparent. If petitioner would find in *Exhibit Supply Co.* a statement that correction of misdescriptive phraseology gives rise to a file wrapper estoppel, such is not the case. Petitioner has omitted from its two separate quotations a part that joined them: that there is file wrapper estoppel ". . . when the applicant in order to meet objections in the Patent Office *based on references to the prior art,* adopted the phrase as a substitute . . ." [emphasis added]

However, for the law one need only return to *Graham* at 383 U.S. 33, this Court's most recent pronouncement: "Claims as allowed must be read and interpreted with reference to rejected ones and to the state of the prior art; and claims that have been narrowed in order to obtain the issuance of a patent *by distinguishing the prior art* cannot be sustained to cover that which was previously by limitation eliminated from the patent." [emphasis added] Of course, petitioner does not point out what the patentee was trying to recapture, even if there were a file wrapper estoppel, and a study of the file will show that former language in the claims is not that which the lower courts held was covered by the doctrine of equivalents.

Lastly, almost as an afterthought, petitioner urges that there is a conflict between the Tenth Circuit, and the Sixth and Seventh Circuits, with respect to the application of the doctrine of file wrapper estoppel. Yet in *Borg-Warner Corp.* v. *Paragon Gear Works, Inc.,* 355 F.2d 400 (1st Cir. 1965), cited by petitioner in support of its position, the Court of Appeals for the First Circuit found ". . . there is no real conflict, except linquistic". (p. 406). There is no conflict of circuits. The Court of Appeals for the Tenth Circuit

merely followed the clear law of *McCullough Tool Co.* v. *Well Surveys, Inc.*, 343 F.2d 381 (10th Cir. 1965), Cert. denied, 383 U.S. 933 (1966), Reh. denied, 384 U.S. 947 (1966); and *Sears Roebuck & Co.* v. *Jones*, 308 F. 2d 705 (10th Cir. 1962), Cert. denied, 371 U.S. 952 (1963), which were not selected for review by this Supreme Court.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted,

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